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In re application of Timur Yarovinsky :
Serial No. : 09/871,607 : DECISION ON PETITION
Filed : May 31, 2001 :
Attorney Docket No.: IOWA:040US/SLH :

This is in response to applicant's petition, filed October 27, 2003 under 37 CFR 1.181, to withdraw the finality of the Office action mailed August 27, 2003.

BACKGROUND

Review of the file history shows that the application was filed May 31, 2001 under 35 U.S.C. 111(a). The application as filed contained 20 claims. A restriction requirement was mailed September 24, 2002. Applicants elected Group I, claims 1-10, without traverse. On January 15, 2003 the examiner mailed a first Office action on the merits, wherein claims 1-10 were rejected. Applicants filed a response, including amendments to the claims, on April 21, 2003. On August 27, 2003 the examiner mailed an Office action which included new grounds of rejection. The examiner made the action final, stating that the new grounds of rejection were necessitated by applicant's amendment.

DISCUSSION

The claim at issue is claim 2, which originally claimed a nucleic acid molecule having either a CCCTT or a TCCTT motif. The claim was rejected under 35 U.S.C. 102(b) over Cheng, which discloses a nucleic acid molecule having a CCCTT motif. When applicant amended the claim to recite only the TCCTT motif, the examiner rejected the claim under 35 U.S.C. 102(e) over Wang, which discloses a nucleic acid molecule having a TCCTT motif.

Applicant argues that the rejection of claim 2 over Wang could have been made in the first Office action. This argument is not persuasive for two reasons. First, the prior art appears to recognize that the two motifs are functional equivalents. For instance, the specification itself uses the notation (T/C)CCTT to designate the topoisomerase cleavage site, indicating that either motif will be recognized by the enzyme. Since one motif would appear to render the other obvious, and the amended claim would appear to be of little value if allowed (since an equivalent non-infringing nucleic acid could be made by

changing one nucleotide), it is understandable that the examiner did not anticipate applicant's amendment.

Second, while Wang *could* have been cited, examiners are admonished not to cite unnecessary references. MPEP 904.03 states, in part:

In selecting the references to be cited, the examiner should carefully compare the references with one another and with the applicant's disclosure to avoid the citation of an unnecessary number. The examiner is not called upon to cite all references that may be available, but only the "best."


Since Cheng is a 102(b) reference (a statutory bar) while Wang is a 102(e) reference (which can be antedated), Cheng was clearly the better reference. Cheng is still applied to other claims, but Wang is now the best reference for claim 2.

DECISION

Applicant's petition is **DENIED**.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA, 22313-1450, or by telephone at (571) 272-0974 or by facsimile transmission at (571) 273-0974.

John Doll 
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